

Remarks

This Application has been carefully reviewed in light of the Office Action mailed May 12, 2004. Applicant appreciates the Examiner's consideration of the Application. Although Applicant believes all original claims are allowable over the prior art of record, Applicant amends Claims 1, 13, 17, 19, and 30. Certain of these amendments have not narrowed the claims and none are considered necessary for patentability. Applicant also submits new Claims 31-53. No new matter has been added. Applicant respectfully requests reconsideration and allowance of all pending claims.

The Claims are Allowable over *Miller* and *Zhang*

The Examiner rejects Claims 1-7, 10-14, 16-23, and 26-30 under 35 U.S.C. § 103(a) as being unpatentable over *Miller et al.* (U.S. Patent No. 5,899,979), hereinafter *Miller*, in view of *Zhang et al.* (U.S. Patent 6,016,478), hereinafter *Zhang*. The Examiner also rejects Claims 8-9, 15, and 24-25 under 35 U.S.C. § 103(a) as being unpatentable over *Miller*, in view of *Zhang*, and further in view of *Mankoff* (U.S. Patent No. 6,385,591), hereinafter *Mankoff*. For at least the reasons described below, Applicants respectfully disagree with the Examiner's rejections. Applicant respectfully submits that independent Claims 1, 13, 17, 19, and 30 and their dependent claims are allowable over the cited references for at least the reasons provided below.

**The Proposed Combination of References Fails to Meet
the Limitations Recited in Applicant's Claims**

Independent Claims

Independent Claim 1 is allowable over the proposed *Miller-Zhang* combination at least because neither *Miller*, *Zhang*, nor the proposed *Miller-Zhang* combination discloses, teaches, or suggests a scheduling engine operable to, as recited in Claim 1:

- determine whether the time information comprising the required time period for the item satisfies the schedule criteria comprising the time period schedule criterion by *comparing at least the required time period for the received item with the time period specified in the time period schedule criterion*;

- if the time information comprising the required time period for the received item satisfies the schedule criteria comprising the time period schedule criterion *in that the required time period for the received item falls within the time period specified in the time period schedule criterion, attempt to determine a location for the item within a schedule* according to the time information;
- if the time information comprising the required time period for the received item does not satisfy the schedule criteria comprising the time period schedule criterion *in that the required time period for the received item falls outside the time period specified in the time period schedule criterion, refrain from attempting to determine a location for the item within the schedule* according to the time information; and
- generate the schedule containing the item if the time information comprising the required time period for the received item satisfies the schedule criteria at least in part by assigning the item to one of the plurality of time slots *within the time period specified in the time period schedule criterion*, the time slot having a duration equal to the duration for the item.

In rejecting a previous version of Claim 1, the Examiner concedes that *Miller* fails to disclose “determining whether the time information for the item satisfies one or more scheduling criteria,” but nevertheless asserts that this limitation is disclosed by *Zhang* (See Office Action, Page 3). *Zhang* discloses a method that includes “comparing the received request against a scheduling calendar listing availability of the particular resource at the requested time” and “updating the scheduling calendar [if the particular resource is available at the requested time].” (See col. 7, lines 7-15 of *Zhang*).

However, at a minimum, both *Miller* and *Zhang* fail to disclose, teach, or suggest a scheduling engine operable to:

- determine whether the time information comprising the required time period for the item satisfies the schedule criteria comprising the time period schedule criterion by *comparing at least the required time period for the received item with the time period specified in the time period schedule*

criterion.

Both *Miller* and *Zhang* also fail to disclose, teach, or suggest a scheduling engine operable to:

- if the time information comprising the required time period for the received item does not satisfy the schedule criteria comprising the time period schedule criterion *in that the required time period for the received item falls outside the time period specified in the time period schedule criterion, refrain from attempting to determine a location for the item within the schedule* according to the time information.

Thus, the proposed *Miller-Zhang* combination fails to disclose, teach or suggest the limitations recited in Claim 1, as would be required to support a proper rejection under 35 U.S.C. § 103. Claim 1 is allowable over the proposed *Miller-Zhang* combination for at least these reasons. At least for analogous reasons, independent Claims 13, 17, 19, and 30 are also allowable. Applicant respectfully requests reconsideration and allowance of independent Claims 1, 13, 17, 19, and 30, together with all their dependent claims.

Dependent Claims

Applicant's dependent claims depend on allowable independent claims and are allowable for at least this reason. In addition, certain of Applicant's dependent claims recite further patentable distinctions over the cited references. Applicants discuss several such claims below as examples.

In addition to its dependence on allowable Claim 1, Claim 6 is allowable over the proposed *Miller-Zhang* combination also because neither *Miller* nor *Zhang* discloses, teaches, or suggests a scheduling engine "operable to determine an activity category for the item based on the associated activity and determine whether the activity category for the item belongs to at least one of the activity categories of the schedule criteria to satisfy the schedule criteria," as recited in Claim 6. Col. 3, lines 23-61 of *Miller*, which is identified in the Office Action as disclosing limitations of a previous version of Claim 6, merely describes assigning priorities for different items on a to-do list. However, the identified portion of *Miller* does

not disclose, teach, or suggest using an activity category associated with an item to be scheduled to determine whether the item meets a scheduling criterion. *Zhang* also fails to disclose, teach, or suggest this missing limitation of Claim 6. Thus, Claim 6 is allowable over the proposed *Miller-Zhang* combination. Applicants respectfully request reconsideration and allowance of Claim 6 and, for analogous reasons, Claim 22 and new Claim 35.

In addition to its dependence on allowable Claim 1, Claim 8 is allowable over the proposed *Miller-Zhang-Mankoff* combination also because *Miller*, *Zhang*, nor *Mankoff* discloses, teaches, or suggests a scheduling engine “further operable to generate a link to an image associated with the item, the rendering engine operable to use the link to retrieve the image for display at the location for the item,” as recited in Claim 8. The Office Action concedes that *Miller* and *Zhang* fail to teach this limitation. However, the Office Action asserts that *Mankoff*, which discloses a method and system for electronic organization of coupons, teaches this limitation and further asserts that *Miller* and *Zhang* can be properly combined with *Mankoff* to reject Claim 8. Applicant respectfully disagrees. Figure 3 and col. 3, lines 50-67 of *Mankoff*, which is the portion identified by the Office Action as disclosing the missing limitation of Claim 8, in fact teaches ***a hyperlink 54 to a website of a provider of virtual coupons***. Such a hyperlink does not disclose, teach, or suggest in any manner generating ***a link to an image associated with an item to be scheduled***. Further, as described in detail below, there is no teaching, suggestion, or motivation in the prior art for one of ordinary skill in the art at the time of the invention to combine *Miller* and *Zhang* with *Mankoff* in the manner the Examiner proposes. Therefore, Claim 8 is allowable over the proposed *Miller-Zhang* combination. Applicants respectfully request reconsideration and allowance of Claim 8 and, for analogous reasons, Claims 9, 15 and 24 and new Claims 37 and 38.

In addition to its dependence on allowable Claim 1, Claim 10 is allowable over the proposed *Miller-Zhang* combination also because neither *Miller* nor *Zhang* discloses, teaches, or suggests a scheduling engine “further operable to generate an alt tag for the item, the alt tag comprising information concerning the item for display in response to the user selecting an image associated with the item,” as recited in Claim 10. The Office Action asserts that the “‘fax’ tag or the ‘print’ tag” shown in figure 4 of *Miller* discloses the alt tag of Claim 10.

This is incorrect. As described on page 10, line 29 through page 11, line 3 of the present application, an alt tag, such as an HTML alt tag, displays details regarding a scheduled item when a user selects the item. The fax button and the print button identified by the Examiner are not described as tags that are operable to display such a description of the schedule item, and neither *Miller* nor knowledge generally available to one skilled in the art would suggest that a fax button or a print button would have such a capability. Further, *Zhang* also fails to disclose, teach, or suggest this missing limitation of Claim 10. Thus, Claim 10 is allowable over the proposed *Miller-Zhang* combination. Applicants respectfully request reconsideration and allowance of Claim 10 and, for analogous reasons, Claims 16, 26, and 27 and new Claim 39 and 40.

**The Official Notice Taken in
Rejecting Claims 7 and 14 is Improper**

In addition to its dependence on allowable Claim 1, Claim 7 is allowable also because neither *Miller*, *Zhang*, nor the proposed *Miller-Zhang* combination discloses, teaches, or suggests that “the schedule is generated in Hypertext Markup Language (HTML) format as part of a web page,” as recited in Claim 7. Claim 14 is allowable for analogous reasons. The Examiner concedes that *Miller* does not disclose this limitation, but takes Official Notice that such a limitation is well known in the art for the stated reason that “at the time of the invention, one of ordinary skill in the art would have been motivated to use HTML because of the user friendliness of ease of use of the language. Further, one of ordinary skill in the art would have been motivated to create a calendar using HTML on a webpage and host the calendar on a web server in order to range a larger audience.” Applicant hereby traverses the Office Notice because the asserted facts are not supported by documentary evidence and appear to be the Examiner’s opinions formulated using the present application as a template, which constitutes impermissible use of hindsight.

“Official notice without documentary evidence to support an examiner’s conclusion is permissible only in some circumstances. While ‘official notice’ may be relied on, these circumstances should be rare when an application is under final rejection or action under 37 CFR 1.113. Official notice unsupported by documentary evidence should only be taken by the examiner where the facts asserted to be well-known, or to be common knowledge in the

art are capable of instant and unquestionable demonstration as being well-known. As noted by the court in *In re Ahlert*, 424 F.2d 1088, 1091, 165 USPQ 418, 420 (CCPA 1970), the notice of facts beyond the record which may be taken by the examiner must be ‘capable of such instant and unquestionable demonstration as to defy dispute’” M.P.E.P. § 2144.03 (citing *In re Knapp Monarch Co.*, 296 F.2d 230, 132 U.S.P.Q. 6 (C.C.P.A. 1961)).

“It would not be appropriate for the examiner to take official notice of facts without citing a prior art reference where the facts asserted to be well known are not capable of instant and unquestionable demonstration as being well-known.” M.P.E.P. § 2144.03 (emphasis in original).

The Office Action provides no documentary evidence to support the Official Notice taken by the Examiner, yet the asserted facts are not capable of “instant and unquestionable” demonstration as being well-known. Instead, it appears that the asserted facts are opinions that have been formulated using the present application as a template, which constitutes impermissible use of hindsight. For example, the Examiner’s assertion that generating a schedule of Claim 1 in HTML format was well known in the art at the time of the invention is not capable of instant and unquestionable demonstration as being well-known. If the Examiner continues to maintain his rejection of Claims 7 and 14 based on this reasoning, then Applicant requests the Examiner to provide documentary evidence in the next Office Action, as stated in Section 2144.03(C) of M.P.E.P. Further, if the Examiner is relying on personal knowledge to support the finding of what is known in the art, Applicant requests that the Examiner provide an affidavit or declaration setting forth specific factual statements and explanation to support the finding. (See Section 2144.03(C)-M.P.E.P.).

Applicant respectfully requests reconsideration and allowance of Claims 7 and 14 and, for analogous reasons, new Claim 36.

The Proposed Combination of References is Improper

Even assuming for the sake of argument that either the *Miller-Zhang* combination or the *Miller-Zhang-Mankoff* combination did disclose, teach, or suggest the limitations specifically recited in Applicant’s claims, which Applicant disputes, the rejection of the claims would still be improper because the Examiner has not identified anything in *Miller*,

Zhang, Mankoff, or knowledge generally available to those of ordinary skill in the art at the time of the invention that provides the requisite teaching, suggestion, or motivation to combine *Miller* with *Zhang* or *Miller* with *Zhang* and also with *Mankoff* in the manner and for the reasons the Examiner proposes. The rejected claims are also allowable for at least this reason.

The question raised under 35 U.S.C. § 103 is whether the prior art taken as a whole would suggest the claimed invention taken as a whole to one of ordinary skill in the art at the time of the invention. Accordingly, even if all elements of a claim are disclosed in various prior art references, which is not the case here as discussed above, the claimed invention taken as a whole cannot be said to be obvious without some reason given in the prior art why one of ordinary skill at the time of the invention would have been prompted to modify the teachings of a reference or combine the teachings of multiple references to arrive at the claimed invention.

The M.P.E.P. sets forth the strict legal standard for establishing a *prima facie* case of obviousness based on modification or combination of prior art references. “To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references where combined) must teach or suggest all the claim limitations.” M.P.E.P. § 2142, 2143. The teaching, suggestion, or motivation for the modification or combination and the reasonable expectation of success must both be found in the prior art and cannot be based on an applicant's disclosure. *See Id.* (citations omitted). “Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art” at the time of the invention. M.P.E.P. § 2143.01. Even the fact that references *can* be modified or combined does not render the resultant modification or combination obvious unless the prior art teaches or suggests the desirability of the modification or combination. *See Id.* (citations omitted). Moreover, “To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or

suggested by the prior art. All words in a claim must be considered in judging the patentability of that claim against the prior art.” M.P.E.P. § 2143.03 (citations omitted).

The governing Federal Circuit case law makes this strict legal standard even more clear.¹ According to the Federal Circuit, “a showing of a suggestion, teaching, or motivation to combine or modify prior art references is an essential component of an obviousness holding.” *In re Sang-Su Lee*, 277 F.3d 1338, 1343, 61 U.S.P.Q.2d 1430, 1433 (Fed. Cir. 2002) (quoting *Brown & Williamson Tobacco Corp. v. Philip Morris Inc.*, 229 F.3d 1120, 1124-25, 56 U.S.P.Q.2d 1456, 1459 (Fed. Cir. 2000)). “Evidence of a suggestion, teaching, or motivation . . . may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, the nature of the problem to be solved.” *In re Dembiczak*, 175 F.3d 994, 999, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999). However, the “range of sources available . . . does not diminish the requirement for actual evidence.” *Id.* Although a prior art device “may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so.” *In re Mills*, 916 F.2d at 682, 16 U.S.P.Q.2d at 1432. *See also In re Rouffet*, 149 F.3d 1350, 1357, 47 U.S.P.Q.2d 1453, 1457-58 (Fed. Cir. 1998) (holding a *prima facie* case of obviousness not made where the combination of the references taught every element of the claimed invention but did not provide a motivation to combine); *In Re Jones*, 958 F.2d 347, 351, 21 U.S.P.Q.2d 1941, 1944 (Fed. Cir. 1992) (“Conspicuously missing from this record is any evidence, other than the PTO’s speculation (if that can be called evidence) that one of ordinary skill in the herbicidal art would have been motivated to make the modification of the prior art salts necessary to arrive at” the claimed invention.). Even a determination that it would have been obvious to one of ordinary skill in the art at the time of the invention to try the proposed modification or combination is not sufficient to establish a *prima facie* case of obviousness. *See In re Fine*, 837 F.2d 1071, 1075, 5 U.S.P.Q.2d 1596, 1599 (Fed. Cir. 1988).

In addition, the M.P.E.P. and the Federal Circuit repeatedly warn against using an applicant's disclosure as a blueprint to reconstruct the claimed invention. For example, the M.P.E.P. states, “The tendency to resort to 'hindsight' based upon applicant's disclosure is often difficult to avoid due to the very nature of the examination process. However,

¹ Note M.P.E.P. 2145 X.C. (“The Federal Circuit has produced a number of decisions overturning obviousness rejections due to a lack of suggestion in the prior art of the desirability of combining references.”).

impermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art.” M.P.E.P. § 2142. The governing Federal Circuit cases are equally clear. “A critical step in analyzing the patentability of claims pursuant to [35 U.S.C. § 103] is casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field. . . . Close adherence to this methodology is especially important in cases where the very ease with which the invention can be understood may prompt one 'to fall victim to the insidious effect of a hindsight syndrome wherein that which only the invention taught is used against its teacher.’” *In re Kotzab*, 217 F.3d 1365, 1369, 55 U.S.P.Q.2d 1313, 1316 (Fed. Cir. 2000) (citations omitted). In *In re Kotzab*, the Federal Circuit noted that to prevent use of hindsight based on the invention to defeat patentability of the invention, the court requires the Examiner to demonstrate a motivation in the prior art to combine the references that are alleged to create the case of obviousness. *See id.* *See also, e.g., Grain Processing Corp. v. American Maize-Products*, 840 F.2d 902, 907, 5 U.S.P.Q.2d 1788, 1792 (Fed. Cir. 1988). Similarly, in *In re Dembiczak*, the Federal Circuit reversed a finding of obviousness by the Board, explaining again that the required evidence of such a teaching, suggestion, or motivation is absolutely essential to avoid impermissible hindsight reconstruction of an applicant's invention:

Our case law makes clear that the best defense against the subtle but powerful attraction of hind-sight obviousness analysis is *rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references*. Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability—the essence of hindsight.

175 F.3d at 999, 50 U.S.P.Q.2d at 1617 (emphasis added) (citations omitted).

Applicant respectfully submits that the Examiner has not identified anything in *Miller*, *Zhang*, *Mankoff* or knowledge generally available to those of ordinary skill in the art at the time of the invention sufficient to teach, suggest, or motivate the proposed combination of a method and system for merging to-do list items onto an event list schedule as disclosed in *Miller* with a method and system for peer-to-peer scheduling using email as disclosed in *Zhang*, and also with a method and system for electronic organization of coupons as disclosed in *Mankoff*. Applicant respectfully submits that the Examiner's speculation that “at

the time of the invention, one of ordinary skill in the art would have been motivated” to combine the teachings of *Miller* with *Zhang* to provide “an electronic calendar better suited for multiple individuals at different locations,” in hindsight with the benefit of Applicant’s claims as a roadmap for selecting portions of multiple references, is insufficient under the M.P.E.P. and governing Federal Circuit case law. Further, Applicant respectfully submits that the Examiner’s speculation that “at the time of the invention, one of ordinary skill in the art would have been motivated” to combine the teachings of *Miller* with *Zhang* and with *Mankoff* to provide “a means to automatically download images and information,” in hindsight with the benefit of Applicant’s claims as a roadmap for selecting portions of multiple references, is also insufficient under the M.P.E.P. and governing Federal Circuit case law.

CONCLUSION

Applicant has made an earnest attempt to place this case in condition for allowance. For at least the foregoing reasons, and for other reasons clearly apparent, Applicant respectfully requests full allowance of the Application.

If the Examiner believes that a telephone conference would advance prosecution of this Application in any manner, the Examiner is invited to contact Applicant's Attorney, Christopher W. Kennerly, at the Examiner's convenience at (214) 953-6812.

Applicant believes that an amount of \$414.00 is due for adding 23 new dependent claims. The Commissioner is hereby authorized to charge these fees and any extra fee or credit any overpayments to Deposit Account No. 02-0384 of Baker Botts L.L.P.

Respectfully submitted,

BAKER BOTTS L.L.P.
Attorneys for Applicant



Christopher W. Kennerly
Reg. No. 40,675

Date: August 12, 2004

Correspondence Address:

Customer Number: **05073**